

**CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. § 1.8**

I hereby certify that this COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, Washington, D.C. 20231, on:

Date: 11/8/01

By \_\_\_\_\_

  
Signature of person depositing U.S. Mail



#11  
CX3  
3-7-01

**PATENT**

**IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE**

Applicants:	Robert R. Karpman, et al.	Docket No.:	29763.0100
Serial No.:	09/191,915	Client Ref:	
Filing Date:	November 13, 1998	Group Art Unit:	3731
Title:	METHOD AND APPARATUS FOR DELIVERING MATERIAL TO A DESIRED LOCATION	Examiner:	Julian Woo

**COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE**

Assistant Commissioner of Patents  
Washington, D.C. 20231

**OK to Enter**

Dear Sir:

Concurrent with the timely payment of the issue fee in connection with the captioned application, Applicant hereby provides the following comments on the Examiner's Statement of Reasons for Allowance as set forth in the Notice of Allowability. While Applicant acknowledges the indication of allowable subject matter embodied by claims 1-5, 7, 10-12, 15, 17-19, 23-36, 39-42, 44, 46 and 47, Applicant believes comments are necessary to clarify the record.

In allowing the claims, the Examiner indicated:

"The prior art of record discloses devices and methods for forming fixation masses in bone. However, unlike the prior art of record, the present invention discloses devices and methods where one device consists of a cannulated, threaded shaft for delivery of a fixation substance to a bone. The shaft has at least one slot in a proximal portion of the shaft and at least one slot in a distal portion. The device

also includes the cannulated, threaded shaft engaged with a bone plate. The present invention also discloses methods of strengthening the fixation of a bone fixation device through the injection and formation of masses of fixation substances near at least one of proximal and distal portions of the fixation device after the device is inserted into bone, including the vertebra. Thus, the present invention is distinguishable over the prior art of record, and the claims are allowed."

While Applicant acknowledges that some of the limitations appear in some of the claims, for example, some of these limitations appear in independent claims 1, 10, 23 and 30, however, all of the cited limitations do not appear in all of the allowed claims. Specifically, while Applicant agrees that these features are not shown in the cited prior art, all of the features are not required in any single claim. While it remains Applicant's view that all claims are allowable, Applicant clarifies for the record that each claim is allowable on the basis of the limitations contained therein.

As an example of the potential confusion which may be engendered by the Examiner's comments, the Examiner's Reasons for Allowance tend to suggest that the limitations of ". . . a cannulated, threaded shaft for delivery of a fixation substance to a bone. . ." are combined with the limitation of ". . . the cannulated, threaded shaft engaged with a bone plate." Applicant respectfully submits that those limitations do not need to be combined and do not appear in each claim. With respect to the latter recited limitation, it appears the Examiner's comments are referring to independent claim 10, however it should be made clear that claim 10 recites, "a bone plate engaged with said head portion."

Moreover, the following statement from the Examiner's Reasons for Allowance tends to suggest the recited limitations are combined; ". . . strengthening the fixation of a bone fixation device through the injection and formation of masses of fixation substances near at least one of proximal and distal portions of the fixation device after the device is inserted into bone, including the vertebra." Applicant respectfully submits that those limitations do not need to be combined and, in fact, are not combined in any submitted claim. The limitation preceding the comma appears to be part of independent claim 23 whereas the latter portion, (the vertebra) is part of independent claim 30.

Finally, Applicant submits that the claims not including the limitations cited by the

Examiner are allowable for various other reasons.

Applicant respectfully submits that all claims stand allowable over the art of record and that these Comments on the Statement of Reasons for Allowance do not necessitate withdrawing the case from issuance. Accordingly, Applicant earnestly solicits prompt and favorable consideration of these comments and speedy issuance of the subject application.

Should the Examiner wish to discuss any of the foregoing in greater detail, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

Dated: 1-8-01

By: Michelle R. Orth

Michelle R. Orth  
Reg. No. 43, 844

**SNELL & WILMER, L.L.P.**  
One Arizona Center  
400 East Van Buren  
Phoenix, Arizona 85004-0001  
Telephone: (602) 382-6275

933902.1